BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	
Alok Srivstava	Group Art Unit: 2169
Serial No.: 10/798,545	Examiner: Paul Kim
Filed: March 11, 2004	Confirmation No. 6477
For: Method and apparatus for integrating data from external sources into a database system	

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant submits this Reply Brief in response to the Examiner's Answer mailed on

December 22, 2010.

I.   Claim Rejections under 35 USC § 103

Claims 1-28 are presently pending in the application, and stand rejected. Claims 1, 3, 5,

7, 9, 11, 13, 15, 17, 19, 21, 23, 25, and 27 stand rejected under 35 U.S.C. 103 as obvious over the

combination of Levy, U.S. Patent 5,995,961 (hereinafter "Levy") with U.S. patent 6,546,421,

Wynblatt, et al. (hereinafter "Wynblatt").

(a) Claims 1, 5, and 19

(i) Applicant's Argument

The Applicant has argued in his Appeal Brief that the combination of Levy and

Wynblatt fails to render claim 1 obvious because neither Levy nor Wynblatt teaches a

"search server" that practices the steps of the claimed method. The Applicant notes that the preamble limits the claimed method to being "performed in a search server", where the method (performed in the search server) comprises the "receiving", "using", and "providing" steps.

(ii) The Examiner's Answer

The Examiner's Answer did not deny that the cited references fail to teach a search server performing all of the claim steps. Indeed, the Examiner's Answer readily acknowledges that it is the client in the Wynblatt reference that performs certain actions that allegedly maps to the claimed "providing" step. See Examiner's Answer page 6.

Instead, the crux of the argument in the Examiner's Answer is that the portion of the preamble stating that the method is "performed in a search server" does not actually provide a limitation that limits the scope of the claimed method steps. As such, the Examiner's Answer maintains the rejection on the basis of the client in Wynblatt allegedly performing the recited "providing" step of providing the first and second identifiers as claimed. See Examiner's Answer pages 6-7.

(iii) Response to Examiner's Argument for Claim 1

As a reminder, claim 1 recites the following:

> 1. **A method performed in a search server** of initiating a connection via a network for a streaming data item between a client for the streaming data item and a streaming data item server that contains the streaming data item, the client and the streaming data item server and the client and the search server being accessible to each other via the network, the connection being independent of the search server, and **the method comprising the steps of**:
> receiving a specification of the streaming data item from the client via the network;
> using the specification to make a query on a database system that is accessible to the search server, the query returning a first identifier that identifies the streaming data item; and
> providing the first identifier and a second identifier to the streaming data item server that contains the streaming data item, the second identifier identifying the client and the first identifier and the second identifier being used by the streaming data item server to establish the connection between the client and the streaming data item. (Emphasis added)

The Applicant firstly notes that the preamble explicitly states that the claimed method is "A method performed in a search server". Therefore, the preamble makes clear that the claimed method is directed to a method that is performed in a search server.

Applicant respectfully submits that the Examiner's Answer has improperly ignored this language as a limitation to claim 1. As stated in MPEP 2111.02(I), "Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation." (citing to *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989)). Here, the preamble of claim 1 very plainly limits the method to being performed within the structure of a "search server".

Moreover, MPEP 2111.02(II) makes absolutely clear that the preamble must be considered a limitation to the claims if the preamble is relied upon during prosecution to distinguish from the prior art:

> See also *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d at 808-09, 62 USPQ2d at 1785 ("[C]lear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention. Without such reliance, however, a preamble generally is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention."

Here, there is no question that the Applicant has, and continue to, rely upon the preamble during prosecution to distinguish from the prior art. See Applicant's *Response To A Non-Final Office Action* dated July 28, 2009 and Applicant's *Response To Final Office Action* dated June 9, 2010.

> MPEP 2111.02 also provides as follows:
>
> "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

For claim 1, there is no question that the preamble is "necessary to give life, meaning, and vitality" to the claim, since the preamble provides antecedent basis for many of the claim elements later recited in the body of the claim. For example, the element "the streaming data item" recited in every step of the claim has its antecedent basis in the preamble which recites "a streaming data item" on line 2.

All of the recited steps in claim 1 are subsequently recited as part of steps comprised in "the method" (i.e., from the phrase "the method comprising the steps of:", with the specific method steps following this transitional phrase). The word "the" before the word "method" very clearly means that the recited "method" is the same as the previously recited "A method performed in a search server". This means that the steps subsequently recited for "the method comprising the steps of" MUST also be steps that are within the antecent "A method performed in a search server". As such, the recited method steps must indeed be limited to a method that is "performed in a search server", as recited in the first part of the preamble. To infer otherwise would very simply ignore the antecedent basis for the phrase "the method comprising the steps of".

The Examiner's Answer also wrongly argues on page 7 that the portion of the preamble which recites "the connection being independent of the search server" would contradict the situation where the search server passes an identifier to a streaming data item server, since it is alleged that this situation would mean that "every connection would necessarily pass through the search server." The understanding of this situation in the Examiner's Answer is incorrect and is contrary to the description in the Specification. As described in the Specification at page 23, line 25 to page 24, line 8, the connection would be established between the streaming data server 1019 and the system 1005, allowing the search server 1007 to "step aside" from the connection and avoid running the connection through the search server.

For at least the above reasons and the reasons expressed in Applicant's Appeal Brief, it is respectfully submitted that the recitation in the preamble "A method performed in a search server" must be considered a limitation to claim 1. As such, it is submitted that the cited Levy and Wynblatt references fail to render claim 1 obvious because neither

Levy nor Wynblatt teaches a "search server" that practices the steps of the claimed method.

(b) Rejection of claims 5, 9 and 19

For at least the reasons expressed above with regards to claim 1, it is respectfully submitted that the combination of Levy and Wynblatt fails to disclose all of the limitations of claims 5, 9 and 19 and the rejection of these claims under 35 U.S.C. 103 as obvious over the combination of Levy and Wynblatt is consequently also without basis.

(c) Rejection of claim 3, 7, 13, 21, and 27

With regard to claim 3, the Applicant first notes that the Examiner's Answer does not address Applicant's argument that there is no indication that the plan generator 114 identified in the cited references is an "object relational database system" within the meaning of the term "object relational" as it is defined at page 9, lines 11-25 of Applicant's Specification, that the plan generator "includes a table containing an object that represents the streaming data item, that the plan generator defines "an open method" for the object [that represents the streaming data item", or that the plan generator "respond[s] to the query by executing the open method".

The Examiner's Answer argues that the term "open method" should be construed as merely any "method", and therefore should be entitled to the broadest reasonable interpretation of just the word "method". However, this construction by the Examiner ignores the word "open" in front of the word "method", and is improper since the Examiner fails to demonstrate that the "plain meaning" of the phrase "open method" is consistent with the word "method" by itself, as is required by MPEP 2111.01(III). The Examiner's Answer likewise fails to identify any ordinary meaning for the phrase "open method". In fact, and contrary to the requirements of MPEP 2111.01, the Examiner fails to consider the express intent within the Specification that the phrase "open method" has a more distinct meaning, e.g., as described in the Specification at page 23, lines 23-25.

For at last the above reasons and the reasons expressed in Applicant's Appeal Brief, it is respectfully submitted that the cited references fails to render claim 3 obvious. The same argument applies as well to claims 7, 13, 21, and 27.

(d) Rejection of claims 2, 4, 6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26, and 28

Claims 2, 4, 6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26, and 28 were previously rejected under 35 USC 103 on the basis of a four reference combination of Levy, in view of Wynblatt, in further view of U.S. Patent Publication 2004/0059720 ("Rodriguez"), and in further view of Official Notice. See Final Office Action dated March 10, 2010 at page 4.

As pointed out in Applicant's Appeal Brief, the Rodriguez reference cannot be employed as prior art to reject the pending claims since it does not have a date earlier than the priority date of the current application. In response, pages 9-10 of the Examiner's Answer has removed Rodriguez from the rejection, so that the former 4-reference rejection has been converted into a new 3-reference rejection. This is impermissible under MPEP 1207.03 since the Examiner's Answer has now introduced a new ground of rejection.

Moreover, Applicant notes that MPEP 2144.03 restricts the circumstances under which the Examiner is entitled to rely upon Official Notice:

> Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113.

In the current situation, the Examiner's Answer has now substituted Official Notice to make up for the removal of Rodriguez from the rejection. It is respectfully submitted that pursuant to MPEP 1207.03, it is improper to substitute Official Notice for the Rodriquez reference in the rejection at this stage of the proceedings, after a final rejection. It is even more improper to do so at this stage of the proceedings without providing documentary evidence.

The Applicant respectfully traverses the portion of the Examiner's Answer that substitutes Official Notice in place of Rodriquez, since it is believed that in the context of a method performed in a search server for initiating a connection via a network for a streaming data item between a client for the streaming data item and a streaming data item server that contains the streaming data item, and where the method performed in the search server provides a first identifier and a second identifier to the streaming data item server that contains the streaming data item, the second identifier identifying the client and the first identifier and the second identifier being used by the streaming data item server to establish the connection between the client and the streaming data item, it is not "common knowledge" for a connection to be initiated the where the first identifier is a URL and the second identifier is a current IP address for the client. The Examiner's Answer has not pointed to any concrete evidence in the record in support of this new Official Notice, nor has the Examiner provided an affidavit or declaration in support of this new Official Notice as is required by MPEP 2144.04(C).

While the Examiner's Answer did refer to Wynblatt at Col. 4, lines 26-46 and 55-59, Applicant notes that nowhere in this cited section is there any teaching or description of a second identifier being the current IP address for a client, much less that second identifier being provided in the context of a method performed on a search server as claimed.

II.   **CONCLUSION**

For the above reasons, Applicant respectfully submits that claims 1-28 are allowable. Accordingly, Applicant requests that the Board of Patent Appeals and Interferences allow claims 1-28.

The Commissioner is authorized to charge any fees due in connection with the filing of this document to Vista IP Law Group's Deposit Account No. **50-1105,** referencing billing number **OID-1999-031-01-DIV1**. The Commissioner is authorized to credit any overpayment or to charge any underpayment to Vista IP Law Group's Deposit Account No. **50-1105,** referencing billing number **OID-1999-031-01-DIV1**.

Respectfully submitted,

DATE: February 22, 2011   By: /Peter C. Mei/
                                        Peter C. Mei
                                        Registration No. 39,768

VISTA IP LAW GROUP, LLP
1885 Lundy Ave., Suite 108
San Jose, California 95131
Telephone: (408) 321-8663 (Ext. 208)
Facsimile: (408) 877-1662